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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,603	12/11/2001	Oswald Gasser	0475-0198P	4201
26813	7590	07/06/2006	EXAMINER	
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,603

Applicant(s)

GASSER ET AL.

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17 and 19-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 20, 21, 24, 26, 27, 39-43 and 47 is/are rejected.
- 7) ☒ Claim(s) 19, 22, 23, 25, 28-38 and 44-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **Indication of Allowability Withdrawn**

The indicated allowability of claims 17, 20, 21, 24, 26, 27 and 39-43 in the office action of February 08, 2006 is withdrawn in view of the newly discovered reference(s) to Jefferies et al (EP 0 304 871). Rejections based on the newly cited reference(s) follow.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 24, 26, 39-43 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Jefferies et al (EP 0 304 871).

Jefferies et al disclose a cone shaped paper point 26 (i.e. “a deformable support material”). A diagnostically useful agent is impregnated on the surface of the cone shaped paper point (page 6, lines 13-15) that reacts with “biological materials present in the mouth that are associated with the diseased state” and “the reaction may be immediately observable or readable” (page 3, lines 54-57). The Jefferies et al device is “locus specific’ in that cone shaped paper point is used for sampling fluids in the root canal and/or periodontal pockets.

Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Kokal, Jr. (US 3,959,881).

Kokal, Jr. discloses a composition comprised of a deformable film 12 14 support material and diagnostically useful additive 16. The additive 16 is comprised of microencapsulated ink or dye that is used to diagnose contact points between the upper and lower teeth. The microcapsules rupture in response to biting pressure which gives the specific location (i.e. "locus-specific") and substance of the contact by indicating points of greater and lesser biting pressure (i.e. "substance specific")(see column 3, line 9-10). The ruptured ink capsules mark the surface of the support material thereby providing a signal (i.e. "signal development").

In response to the present rejection applicant points to column 3. lines 6-7 of Kokal which state that the teeth are marked and argues that rather than marking the teeth, the present claims require "a signal development in or upon the surface of the support material or by binding of a detectable agent to the support material." The examiner is of the position that the Kokal "support material" is a paper and that the ruptured ink or dye microcapsules within the paper would stain and mark the surface of the paper just as ink marks the paper of this page.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 21, 27 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jefferies et al (EP 0 304 871).

In regard to claims 20, 27 and 27, the use of the diagnostic agent in Jefferies et al within the particular quantities claimed would have been obvious to one of ordinary skill in the art as a matter of routine practice in carrying the Jefferies et al invention.

In regard to claims 40-43, to the extent that the disclosed indicator enzymes of Jefferies et al do not meet the laundry list of indicators set forth in the present claims, then one of ordinary skill in the art would have found it obvious to have substituted other known prior art indicators such as those claimed as an obvious substitution of known prior art indicators.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kokal, Jr. (US 3,959,881).

In response to the 35 U.S.C. 102 rejection based on Kokal, Jr. above, applicant argues that the paper with ruptured inks or dyes of Kokal Jr. would not necessarily have to be inherently stained or marked by the ink or dye. The examiner considers the argument being akin to painting an object with a brush and then arguing that there is only paint on the object and none on the brush, be that as it may, to the extent that Kokal, Jr. paper is not inherently stained or marked with the ruptured microcapsules of ink or dye because it could possibly be some unusual type of paper that would not permit such a stain/markings, then it would have been obvious to one of ordinary skill in

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the art to have constructed the Kokal, Jr. device of conventional ordinary paper as a matter of routine practice.

### **Allowable Subject Matter**

Claims 19, 22, 23, 25, 28-38 and 44-46 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend.


### **Prior Art**

Applicant's information disclosure statements of May 08, 2006 and May 24, 2006 have been considered and an initialed copy enclosed herewith.

Berry (US 3,507,269) is made of record.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R. Lewis  
June 24, 2006

  
Ralph A. Lewis  
Primary Examiner  
Au 3732